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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,199	11/21/2001	Annie Audibert-Hayet	PET-1969	9312
23599	7590	01/07/2005	EXAMINER	
MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201			TUCKER, PHILIP C	
			ART UNIT	PAPER NUMBER
			1712	

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/989,199

Applicant(s)

AUDIBERT-HAYET ET AL.

Examiner

Philip C Tucker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,11,12,14-27 and 29-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12,15,16,18,20,29 and 32 is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,7,11,14,17,19,21,23-27,32 and 33 is/are rejected.
- 7) ☒ Claim(s) 8-10,13 and 28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. The finality of the previous office action is hereby withdrawn, and superceded with the present office action in view of new rejections presented herein. Applicants amendment presented after final has been entered.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 2, 4, 5, 7, 11, 17, 19, 24-27 and 32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 12-14, 17, 20, 22, 23-27, 29 and 33-42 of copending Application No. 09/953209. Although the conflicting claims are not identical, they are not patentably distinct from each other because although the claims of the present invention differ in not stating the use of a demulsifier in addition to the ester, the ester is both an emulsion-breaking agent and an organic base, and such would render the claims of the present invention obvious to one of ordinary skill in the art, since the formulation of

09/953209 overlap in scope, and can comprise the same components as the composition of the present invention. Claim 19 is obvious over the claims of 09/953209, since a demulsifying composition would be used to break an emulsion.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 14 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Mueller (4964615).

Mueller teaches a fluid for use in wells comprising esters of natural or vegetable fatty acids (see column 4, lines 10-16). Since the ester is also an organic base, the present claims are not distinguished. The fluid further comprises a viscosifier such as clay (column 4, lines 61-68), fatty acid, alkylsulfonic acids or salt thereof, which are anionic wetting agents (column 5, lines 27-38), and calcium carbonate as a weighting agent (column 6, lines 17-26). The viscosifier (thickener) is present within the scope of

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claims 14 and 21 (column 5, lines 44-45). Applicants intended use as a emulsion breaking formulation does not distinguish over the prior art (In re Pearson 181 USPQ 641).

6. Claims 14, 21 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Patel (6218342).

Patel teaches a oil-based composition used in drilling which comprises an organic base of dialkyl carbonates, an ester within the scope of the present invention (Fina Green), organophilic clay viscosifier and calcium carbonate (see Example 7). Anionic wetting agents such as tall oil may be utilized (column 6, lines 56-57). Applicants intended use as a emulsion breaking formulation does not distinguish over the prior art (In re Pearson 181 USPQ 641).

7. Claims 21, 23 and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Santhanam (6339048).

Santhanam teaches an oil based composition which is used in drilling a well which comprises the reaction product of a polymerized vegetable oil and an aminoalcohol (see column 10, lines 11-21, column 11, lines 1-65 and Table 1). The reaction product is used with an anionic wetting agent of Tall oil fatty acid (see formulation A in column 16). Applicants intended use as a emulsion breaking formulation does not distinguish over the prior art (In re Pearson 181 USPQ 641).

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, the emulsion breaking agent cannot be present at a level of 100%, since according to clai 1, the wetting agent must also be present in the formulation.

10. Claims 3, 6, 22, 30, 31 and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


11. Claims 12, 15, 16, 18, 20, 29 and 32 are allowable over the art of record.

12. Applicant's amendment and comments have been noted. Applicant's cancellation of claim 28 removes the double patenting rejection. New rejections are presented in this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C Tucker whose telephone number is 571-272-1095. The examiner can normally be reached on Monday - Friday, Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Philip C Tucker
Primary Examiner
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PCT-3240